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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,790	07/05/2000	FUJIO MORI	2000-0938A	2735

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EXAMINER
UHLIR, NIKOLAS J

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-11

Office Action Summary	Application No.	Applicant(s)	
	09/582,790	MORI, FUJIO	
	Examiner	Art Unit	
	Nikolas J. Uhlir	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☒ The proposed drawing correction filed on *06 November 2002* is: a)☒ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This office action is in response to the amendment and arguments submitted on 11/06/02. The examiner hereby withdraws the rejection dated 5/06/02. After carefully considering the applicants arguments and reviewing the prior office action, the examiner feels the position of the office was not presented in a manner that would allow the applicant to clearly understand the position of the office. Accordingly a new non-final action on the merits follows.

Specification

1. The amendment filed 11/06/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Page 31 of the substitute specification replaced "5" in the 4th line of the page with "30," "500" in the 5th line of the page with "30," and "500" with "100" in the 17th line of the page. There is no support for these replacements in the in the application as filed. Thus, these replacements constitute new matter.

Applicant is **required** to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. In the instant case, these claims require a material that is "easily vaporizable and foamable." The term "easily" in claim 35 is a relative term that renders these claims indefinite. The term "easily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The primary issue with a phrase such as "easily vaporizable and foamable" is that the term "easily" can be interpreted by different people differently. In order for the term "easily" to be definite, applicants need to define the term in such a way that one of ordinary skill in the art would be apprised of the scope of invention, either through a physical property range (i.e vapor pressures for the material) or other means.

4. Claims 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the instant case, these claims require "a dimensional change rate of 0.6%." This requirement is confusing to the examiner. Claims 39-42 require a "rate." Rates are mathematically defined to be a measure of a change in a value over a period of time, i.e miles/hour, ft/sec, mm/min etc. Thus, as applicants in claims 39-42 only provide a percentage value, and do not provide any units relating to time, it is unclear what the applicants "rate" is claiming. Applicants in their arguments explain that the dimensional change rate is defined by the equation:

"{(distance between the chucks at breakage)-(distance between the chucks before the tensile test)}*100/(distance between the chucks before the tensile test).

This equation does not describe a "rate," as it does not define what dimension is changing over what time span. The equation provided by the applicant appears to be an

accurate calculation for "% tensile elongation at break," not "dimensional change rate. Last, applicant's equation is not supported by the specification.

5. Thus it the requirements of claims 39-42 are unclear as the definition of "dimensional change rate" is unclear.

Examiners Note

6. To b clear on the record, the limitations "for use...solid body" in claim 22, "the process...solid body" in claim 23, "for use...bonded to the solid body" in claims 39 and 41 are intended use limitations and do not appear to be further limiting in so far as the structure of the product is concerned. "[I]n apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art." *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). See MPEP § 2111.02. In the instant case, the preamble of each claim establishes that these claims are directed towards a decorating sheet and a method for manufacturing a decorating sheet, not the "use" of the decorating sheet in a process for forming a decorated article.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 22-28, 33-36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (JP09300397).

9. For the purpose of this investigation, a written translation of the Mori et al. and Kitamura et al. documents is utilized to provide the basis for the rejection below. Copies of these written translations accompany this office action. All references to these documents refer to these translations.

10. With respect to the limitations of claim 22, Mori et al. teaches an insert film used to obtain molded products having a wood grain pattern. This insert film comprises an acrylic layer 2 (equivalent to applicants substrate sheet), a grain pattern layer 3, a base layer 4, a color sheet 5 (equivalent to applicants claimed backing sheet), and an adhesive layer 8 (page 8, section 14).

11. With respect to the property limitations of claim 22, although the examiner acknowledges that Mori et al. does not specifically teach these required properties, Mori et al. does teach that the thickness of both the color sheet 5 and the acrylic film 2 have an impact on the mechanical strength exhibited by the film. (sections 25 and 36).

12. Further, in a specific embodiment, Mori et al. teaches a 125μ (.125mm) methyl methacrylate (an acrylic) layer, upon which is formed a pigmented 400μ (.4mm) polyacrylonitrile-butadiene-styrene (ABS) layer as the color layer (section 63). This example is very similar to those disclosed by the applicant in the table on page 30 of the instant specification, wherein applicant describes the properties of in-mold decorating

sheets utilizing an acrylic substrate sheet that is .07μ thick and an ABS backing sheet that is 0.33mm thick as having properties meeting applicants claim limitations, and that as the thickness of the backing layer goes up, the young's modulus of the film increases. It should be noted also that the specification does not appear to describe any process steps that would result in the materials utilized for the backing and substrate sheets to be chemically different (i.e through extra crosslinking, annealing, etc...) from those described in Mori et al.

13. Thus, as the specific example of Mori et al. matches the materials used by the applicant for both the substrate and backing sheets (acrylic and ABS), and because the backing layer of this example exceeds the thickness of all of the examples listed in the table on page 30 of the instant specification, the examiner takes the position that the film of Mori et al. will necessarily possess or exceed the properties required by claim 22.

14. It has been held that where claimed and prior art products are identical or substantially **identical in structure or composition**, or are produced by identical or substantially identical processes, **a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant** to show that prior art products do not necessarily on inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709,

15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prime facie* case can be rebutted by ***evidence*** showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433.

15. Regarding the process limitations for forming a decorated article required by claim 22. Applicants are reminded that claim 22 is directed towards a decorating sheet, not a method for manufacturing a decorated article. However, for completeness, Mori et al. teaches the applicants process in section 41 of the translation.

16. Regarding the limitations of claim 23 requiring the in-mold decorating sheet to have a product of young's moduls and cube of thickness of at least 1 kgfmm. The examiner takes the position that the film of Mori et al. as stated above for claim 22 necessarily meets this limitation. Mori et al. teaches a film that is made of the same materials as that listed by the applicant on page 30 of the specification, and exceeds the thickness of the substrate and backing layers utilized by the applicants film (which upon examination of applicants examples would likely result in a film exhibiting a higher young's modulus then any of applicants examples).

17. Regarding the process limitations in claim 23, once again, applicant is respectfully reminded that claim 23 is directed towards an in-mold decorating sheet, not a method of making a decorated article. However, these limitations are met as set forth above for claim 22.

18. Regarding the limitations of claim 24, wherein applicant requires the decorating sheet to have a specific pencil hardness on the side of the sheet opposite the side to be bonded to the resin. The examiner again takes the position that the film of Mori et al.

necessarily meets the property limitations required by the applicant in the instant claims, as stated above for claims 22-23. The film of Mori et al. matches the materials utilized by the applicant, and exceeds the thickness of applicant's films. Further, ABS resin is listed as a material having the required pencil hardness on page 42 of the instant specification.

19. Regarding the limitations of claim 25, wherein applicant requires that the substrate film is manufactured from one of the materials listed. Mori et al. clearly teaches utilizing acrylics to form the substrate sheet, as stated above. Thus, as acrylics are listed as suitable materials to meet the requirements of claims 25, this limitation is met.

20. Regarding the limitations of claim 26, wherein the applicant requires wherein the applicant requires the thickness of the decorating sheet to be $\geq 250\mu$, wherein the thickness of the decorating sheet minus the backing sheet is $\leq 200\mu$, and the color of the backing sheet is within the specified range. Mori et al. in a specific example teaches a 125μ acrylic substrate that is coated with a wood grain layer, a base layer, and a 400μ thick ABS color sheet (equivalent to applicants backing layer). Thus, the total thickness of the decorating sheet of Mori et al. is 525μ ($125\mu + 400\mu$) (sections 61-62). Mori et al. further teaches that the total thickness of the insert film should not be greater than 600μ (section 38). Thus, it is logical to conclude that the maximum thickness of the wood grain layer and the base layer is 75μ (600μ-525μ), resulting in the maximum thickness of decorating sheet minus the backing sheet to be 200μ (75μ+125μ). Thus, as the thickness of the decorating sheet of Mori et al. exceeds 250μ, and the thickness of the

decorating sheet minus the backing sheet is at most 200μ, the thickness limitations of claim 26 are met.

21. Regarding the color limitations of claim 26. Mori et al teaches that the color sheet is pigmented (section 32). It is well established in the art that the amount and type of a pigment utilized to color a resin material affects the resulting color, hue, lightness, etc.. of the resin.

22. Therefore it would have been obvious to one with ordinary skill in the art to change the type and amount of pigment used in the color sheet of Mori et al. to achieve a desired color.

23. One would have been motivated to make such a modification for many reasons, including aesthetic appeal and color matching of the color sheet to the grain pattern layer.

24. With respect to the limitations of claim 27, wherein the applicant requires the backing sheet to be formed from one of the listed materials. Mori et al. clearly teaches a color sheet (equivalent to applicants backing sheet) of ABS (acrylonitrile butadiene styrene resin as stated above. As ABS resin is listed a suitable for forming the backing sheet in claim 27, this limitation is met.

25. Regarding the limitations of claim 28, wherein applicants require the backing sheet to be of a material that prevents vaporization and foaming.

26. Although Mori et al. does not specifically teach this limitation, Mori et al. does teach a color sheet (equivalent to applicants backing sheet) formed of ABS resin, as stated above. As elucidated by claim 36, ABS resins prevent vaporization and foaming.

Thus, as the material utilized by Mori et al. matches one of the materials listed as a suitable material for preventing vaporization and foaming. This limitation is met. Applicants are referred to the citation of In Re Best in paragraph 15 above.

27. With respect to the limitations of claims 33, wherein applicant requires wherein applicant requires a first pattern layer to be formed between the substrate sheet and the backing sheet. Mori et al. teaches the formation of a wood grain pattern layer (equivalent to applicants claimed 1st pattern layer between an acrylic layer (equivalent to applicants claimed substrate) and the color sheet (equivalent to applicants backing layer) (page 2, claim 1 of translation and figures 1 and 2). Thus, the limitations of claim 33 are met.

28. Regarding the limitations of claim 34, wherein applicant requires a second pattern layer between the backing sheet and the substrate sheet. Mori et al. teaches the formation of a base layer and a wood grain pattern layer between the substrate and the backing sheet (page 2, claim 1, figures 1 and 2). The base layer can be patterned (section 19). Thus, the examiner takes the position that when the base layer is patterned, it is equivalent to applicants claimed 2nd patter layer.

29. Regarding the limitations of claims 35 and 36 wherein applicant requires the material of the substrate to be an easily vaporizable and foamable material, and the material of the backing sheet to be a material which prevents vaporization and foaming (claim 35), specifically where the material of the backing layer is one of the materials listed in claim 36.

30. Mori et al. teaches a color sheet (equivalent to applicants backing sheet) formed of ABS resin, and thus meets the limitations for the backing sheet in claims 35 and 36. Regarding the requirement that the substrate sheet be "easily vaporizable and foamable," as stated above the term "easily" is highly subjective and renders the scope of this phrase indefinite. For the purpose of this examination, the examiner takes the position that acrylics meet the definition of "easily vaporizable and foamable," as the applicant in the instant specification utilizes an acrylic substrate layer in every example. Thus, as Mori et al. teaches an acrylic substrate layer, the limitations of claim 35 and 36 are met.

31. Regarding the limitations of claim 43, wherein the applicant requires method for forming a decorated article utilizing an in-mold decorating sheet. The material properties required by claim 43 are met as set forth above for claim 22. Further, Mori et al. in sections 40 and 41 of the translation teaches the method limitations required by claim

32. Claims 29-32 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. as applied to claim 22 above, and further in view of Lau et al. (US2001/0020047).

33. Mori et al. teaches that suitable resin materials for the color sheet (equivalent to applicants backing layer) include polypropylenes, polyurethanes, EVA, ABS, and other resins (section 32).

34. Therefore it would have been obvious to one of ordinary skill in the art to utilize polypropylene as the color layer in Mori et al., as polypropylene is taught to be equivalent to the other resins listed as suitable.

35. Applicants are respectfully reminded that substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency. *In Re Fount* 213 USPQ 532 (CCPA 1982); *In Re Siebentritt* 152 USPQ 618 (CCPA 1967); *Grover Tank & Mfg. Co. Inc V. Linde Air Products Co.* 85 USPQ 328 (USSC 1950).

36. However, even when polypropylene is utilized as the color sheet, Mori et al. does not teach a backing sheet that has a shrinkage factor that differs from the shrinkage factor of the substrate sheet by 0-.008, as required by claim 29. Nor does Mori et al. teach utilizing a polypropylene film containing 20-150 parts by weight of an olefin rubber and 5-20 parts by weight of talc, as required by claims 30-32.

37. However, Lau et al. teaches a polyolefin mixture suitable for molding that exhibits improved surface characteristics, such as scratch resistance and abrasion resistance (sections 3 and 83). Examples of suitable polyolefin's taught by Lau et al. include polypropylene, polyethylene, and other C_5-C_{20} olefins (section 29). The polyolefin mixture comprises 55-99% by weight of a base polyolefin such as polypropylene, 1-30 weight % of a ethylene/α-olefin copolymer, such as a copolymer of ethylene and propylene, and 1-30 weight % of a filler such as talc (sections 30, 32, and 41). The addition of the ethylene/α-olefin copolymer and the talc filler improves the surface characteristics of the polyolefin (sections 3, 32 and 41)

38. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate 1-30% by weight of a filler such as talc and 1-30% by weight of a ethylene-propylene copolymer as taught by Lau et al. into the polypropylene layer of Mori et al.

39. One would have been motivated to make this modification due to the teaching in Lau that the surface characteristics of a polyolefin such as polypropylene are improved through the incorporation of a an ethylene/α-olefin copolymer and a filler.

40. Regarding the specific selection of Talc and ethylene-propylene as the additives to the propylene film of Mori et al., one would have been motivated to select these materials in particular as they are taught to not only be equivalent to the other materials listed as suitable additives in Lau et al., but are also listed as being "preferred" additives.

41. Thus, the combination of Mori et al. with Lau et al. results in a decorating film that has an acrylic base, and a propylene backing layer that contains the same additives in the required amounts as required by claims 29-32. Thus, as the decorating sheet resulting from the combination of Mori et al. with Lau et al. is manufactured from the same materials required by claims 30-32, the examiner takes the position that the limitation of claim 29, wherein applicant requires a specific shrinkage difference between the substrate and the base sheet is met. Applicants are referred to the citation of In Re Best above.

42. Regarding the limitations of claims 37-38, which requires many of the same requirements as claims 29-32, with the exception being that the applicant requires the backing sheet to comprise "plural" sheets. Mori et al. teaches that the color sheet can be formed of multiple layers (section 32).

43. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the color sheet of Mori et al. as a multiple layer, as this structure is taught to be equivalent to a single layer color sheet.

44. As stated above, it has been established that it would have been obvious to form the color sheet of Mori et al. from polypropylene. Thus, when polypropylene is utilized to form the multilayer color sheet, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a filler such as talc and an additive such as ethylene-propylene copolymer as taught by Lau et al. into the polypropylene layers making up the multilayer polypropylene color sheet of Mori et al.

45. One would have been motivated to make this modification due to the teaching in Lau that the surface characteristics of a polyolefin such as polypropylene are improved through the incorporation of a an ethylene/α-olefin copolymer and a filler.

46. Regarding the specific selection of Talc and ethylene-propylene as the additives to the propylene film of Mori et al., one would have been motivated to select these materials in particular as they are taught to not only be equivalent to the other materials listed as suitable additives in Lau et al., but are also listed as being "preferred" additives.

47. Thus, the combination of Mori et al. with Lau et al. results in a decorating film that has an acrylic base, and a multilayer propylene backing layer that contains the same additives in the required amounts as required by claims 29-32. Thus, as the decorating sheet resulting from the combination of Mori et al. with Lau et al. is manufactured from the same materials required by claim 38, the examiner takes the position that the

limitation of claim 29, wherein applicant requires a specific shrinkage difference between the substrate and the base sheet is met. Applicants are referred to the citation of In Re Best above.

48. Claims 39-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. as applied to claims 1 and 43 above, further in view of Kitamura et al. (0475085).

49. A written translation of the Kitamura et al. document accompanies this office action.

50. Regarding the limitations of claims 39-42, wherein the applicant requires a specific method for manufacturing an in-mold decorating sheet, Mori et al. teaches all of the requirements for forming the decorated article in sections 40-41 of the translation, and meets the property requirements for the decorating film as set forth above for claim 22. Further, Mori et al. teaches forming the decoration film by laminating the layers to one another in the respective order (section 35).

51. However, Mori et al. does not teach forming the pattern layer on either the backing sheet or the substrate sheet by laminating a carrier having a dimensional change rate of 0.6% under a temperature of 90^0 C onto one of the backing sheet and substrate sheet; and covering the pattern layer with the other of the backing g or substrate sheet such that the pattern layer is between the substrate and backing sheet (as required by claim 39), wherein the carrier is removed prior to covering the pattern (as required by claim 41), wherein the carrier sheet exhibiting a dimensional change rate of 0.6% is a biaxially oriented polyester or polypropylene film (as required by claims 40 and 41).

52. However, Kitamura et al. teaches a method for transferring a pattern (functional) layer to a planar or 3d shaped article, such that the pattern can be precisely positioned and formed without breaking (page 2, section 3, page 6, second paragraph, page 8, 1st paragraph, and page 11, lines 1-4). This method includes forming a pattern (functional) layer on the surface of a biaxially stretched polyolefin (equivalent to applicants claimed carrier sheet) such as biaxially stretched polypropylene, wherein a release layer is formed between the pattern and biaxially stretched layers, adhering the 3 layer film to the planar or 3d shaped article, and removing the biaxially stretched layer (page 4-9, figure 3).

53. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the method taught by Kitamura et al. to form the pattern layer on the acrylic substrate taught by Mori et al.

54. One would have been motivated to utilize this method due to the teaching in Kitamura et al. that utilizing a transfer foil such as the one described allows for a pattern layer to be precisely applied to a planar or 3d shaped article without breakage.

55. Regarding the property requirements for the carrier sheet required by claims 39-42, the examiner takes the position that these requirements are met, as the carrier sheet of Kitamura et al. identically matches one (biaxially oriented polypropylene) of the materials in claims 40 and 42 which are listed as suitable materials possessing these properties. Applicants are respectfully referred to the citation of In re Best above.

Response to Arguments

56. Applicant's arguments filed 11/06/02 have been fully considered but they are not persuasive.

57. In the instant case, applicants argued that "easily vaporizable and foamable" materials would be fully appreciated by one of ordinary skill in the art. The examiner respectfully disagrees. In addition to the argument set forth under 35 U.S.C 112 above, the examiner respectfully points out that that term "easily" is inherently indefinite, as can be interpreted by different people different ways. For example, a biker who is prime athletic shape would consider biking up a moderate incline to be "easily" done, however, a severely out of shape person performing the same task would certainly disagree. Thus, the 112 rejection of this phrase is maintained.

58. Further, applicants argued that the "dimensional change rate" as claimed is obtained by performing a tensile test until the specimen is broken, and is calculated by the equation submitted in the arguements. The examiner is highly confused by this statement and equation, as it seems to indicate that applicant's "dimensional change rate" is in fact % tensile elongation at break. The examiner fail to see how a "rate," which necessarily is defined by a change in a defined variable over a unit of time can be accurately described by the applicants equation. The examiner respectfully requests the applicant review the translation of the Japanese priority documents to see if this is in fact the correct terminology for this property. Accordingly, the 112 rejection of this material property is maintained.

59. Additionally, applicants submit that the examiner has not full-filled his obligation to provide some basis in fact and/or technical reasoning to reasonably supply that the

materials of the prior art will possess the required properties presented in claim 1. The examiner feels that this is due to the prior office action being unclearly written, for which the examiner apologizes.

60. The examiner respectfully submits that the fact that the prior art materials identically match the materials cited in the claims for use as the substrate layer and the backing layer provides a basis in fact and/or technical reasoning to infer that the materials of the prior art will possess the characteristics required by the claims. The examiner acknowledges that the claims must be read in light of the specification, and has searched the specification for guidance as to how these properties are obtained. A thorough search of the specification provided no evidence that the materials utilized by the applicant for the substrate and the backing layer undergo any particular processing steps so as to imbue the resulting article with the claimed properties. Thus, by establishing that the materials of the prior art and that of the instant application are "substantially identical in structure and or composition, **a *prima facie* case of either anticipation or obviousness has been established and the burden of proof is shifted to applicant** to show that prior art products do not necessarily on inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC 102 or on *prima facie* obviousness under 35 USC 103, jointly or alternatively. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

61. If applicants disagree with the examiners reading of the specification, the applicants are respectfully invited to particularly point out portions of the specification

that establish that the properties required by the instant claims are not inherent to the materials utilized.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 703-305-0179. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0389.

nju
January 10, 2003

STEVAN A. RESAN
PRIMARY EXAMINER